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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/025,548	12/26/2001	Tsuneo Yashiki	ZU-319/CONT	1823

7590 12/04/2002  
SHERMAN & SHALLOWAY  
413 North Washington Steet  
Alexandria, VA 22314

EXAMINER

LU, C CAIXIA

ART UNIT	PAPER NUMBER
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1713

7

DATE MAILED: 12/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/025,548

Applicant(s)

YASHIKI ET AL.

Examiner

Caixia Lu

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on September 9 and 30, 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 08/651,492.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. Claims 2 and 3 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention for the same rationale as set forth in the previous office action, Paper No. 2.

***Claim Rejections - 35 USC § 103***

2. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sasaki (US 4,891,411), Kioka (US 4,952,649), and Cuffiana et al (US 5,278,118) independently for the same rationale as set forth in the previous office action, Paper No.

2.

***Response to Arguments***

3. Applicant's arguments filed on September 9 and 30, 2002 have been fully considered but they are not persuasive.

Applicant argues against the rejections made under 35 U.S.C. 103(a) over Sasaki (US 4,891,411) and Kioka (US 4,952,649) by comparing the ~~activity of~~ catalytic activities of applicant's catalyst and those cited in Sasaki and Kioka. However, applicant's has not introduced any new evidence in their arguments. Because the Board of Patent Appeals and interferences has already made decision with regard to Kioka and Sasaki based on all of the evidences of the record, no further consideration is required.

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Declaration under 37 CFR 1.132 on September 9 and 30, 2002 to show that applicant's catalyst has unexpected high catalytic activity compared to Cuffiana's working example A9. Applicant has shown that, at applicant's polymerization condition, the catalyst reproduced based on Cuffiana's Example A9 has the activity of 4,520 g-polymer/g-catalyst or 25,682 g-polymer/g-Ti (calculated from 4520/17.6 wt.%) while the catalyst of the instant claims has the catalytic activity of 45,500 g-polymer/g-Ti of catalyst. It seems that the catalyst of the instant claims has superior catalytic activity compared to Cuffiana's Example A9 under applicant's polymerization condition. However, under patentee's polymerization conditions, the catalytic activity of Cuffiana's Example A9 listed in Table I of the reference is 23,000g-polymer/g-catalyst or 133,721 g-polymer/g-Ti (calculated from 23,000/17.2 wt.%) which is about five times higher compared to the activity of 4,520 g-polymer/g-catalyst or 25,682 g-polymer/g-Ti of the same catalyst reproduced by the applicant tested under applicant's condition. It is understood that a different olefin polymer is prepared in patentee's polymerization condition rather than the ethylene homopolymer. However, considering the unpredictable nature of activity behavior of the catalyst, one could not possibly predict that the catalyst of the instant claims to have superior catalytic activity over that of the catalyst of Cuffiana's Example A9 when tested under Cuffiana's polymerization conditions.

Because the catalysts of the instant claims are not limited to the specific catalytic activity under the specific condition, applicant's showing of criticality and unexpected results is not commensurate with the scope of the instant claims.

**Conclusion**

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Caixia Lu whose telephone number is (703) 306-3434. The examiner can normally be reached on 9:00 a.m. to 3:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703) 308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1193.



Caixia Lu  
Examiner  
November 29, 2002